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In re Application of :
Gabriel Lopez-Berestein et al :
Serial No.: 09/982,113 : PETITION DECISION
Filed: October 17, 2001 :
Attorney Docket No.: UTSC:660US :

This is in response to the petition under 37 CFR 1.181, filed November 4, 2004, requesting entry of an amendment after Final rejection.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on February 20, 2004, setting a three month shortened statutory period for reply, which set forth three separate rejections under 35 U.S.C. 103(a). Applicants filed an amendment on April 14, 2004, in which claim 54 was amended to delete part of a phrase and limit the composition lipid material to DMPC and water, a limitation imported from claim 138 which was canceled. By Advisory Action, mailed June 4, 2004, the examiner refused entry of the amendment as raising new issues, specifically under 35 U.S.C. 112, second paragraph. Applicants filed a Notice of Appeal on July 6, 2004, accompanied by an Appeal Brief. The Appeal Brief was deemed defective by Notice mailed October 1, 2004, which set a non-extendable one month time period for reply, in that it failed to address the rejection of claims 54-60 and 131-137 (presented prior to Final Office action). Applicants filed this petition on November 4, 2004, accompanied by a new amendment of the claims and a new Appeal Brief.

DISCUSSION

Applicants argue that the reasons for non-entry of the first amendment after Final Office action are not entirely clear on the record. However, the Advisory Action clearly states that the amendment would raise new issues under 35 U.S.C. 112, second paragraph. Applicants' amendment changes the latter part of claim 54 from "wherein said lipid material comprises DMPC and one or more of soybean oil and water" to "wherein said lipid material comprises DMPC and water". Such amendment would be proper if it were not that dependent claim 141 states that the "lipid material comprises DMPC, SO and water". Claim 141 clearly adds materials to the lipid material not found in claim 54 thus raising a consideration under 35 U.S.C. 112, second paragraph. In light of this the examiner's refusal to enter the amendment was not

improper. Applicants' telephone inquiries as noted in the petition did not resolve the problem. However, applicants had ample opportunity to further amend the claims prior to filing of the Appeal Brief and chose not to do so.

It is noted that applicants have filed a new Appeal Brief concurrently with a new amendment of the claims and this petition. This amendment has not been reviewed by the examiner for possible entry nor has the Appeal Brief been reviewed to determine if it complies with current rules applicable thereto.

The petition is **DENIED with respect to entry of the amendment filed April 14, 2004, only.**

The application will be forwarded to the examiner for consideration of the amendment and Appeal Brief filed November 4, 2004.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

A handwritten signature in black ink, appearing to read 'B. M. Kisliuk', with a stylized flourish at the end.

Bruce M. Kisliuk
Director, Technology Center 1600